

REMARKS

Claims 34-63 are pending in this application.

Claims 34, 46 and 56, are independent.

The specification is objected to because of a lack of "Cross-Reference To Related Applications" section. The Examiner's noted concerns have been addressed herein.

Claims 34-63 stand rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 34-52 of U.S. Patent Application Serial Number 09/892,629, in view of claims 1-19 of U.S. Patent Number 6,289,322, and in view of claims 1, 3-6, 8, and 34-57 of U.S. Patent Application Serial Number 09/795,314. The rejections are respectfully traversed.

As best understood, the rejection under the '629 application is based upon the conclusion that claims 34-52 of the '629 application recite generation of a single message authorizing payment of at least one bill, and an Official Notice that it is old and well known in bill consolidation to authorize payment of more than one bill at the same time.

The Examiner's rationale for the rejection under the '322 patent and the '314 application is simply not understood. The Examiner makes the same arguments in rejecting under both the '322 patent and the '314 application. Namely, the Examiner argues that the rejections are based upon the conclusion that "the instant application is broaden [sic] the use of the bill payment system and it would have been obvious to a person of ordinary skill in the art at the time to broaden the scope of the claims in order to cover extent of use of the system".

Each of claims 34-52 of the co-pending '629 application requires display of information representing a first bill and information representing a second bill on a

single screen. Claims 34-63 of the present application lack any recitation of, and hence do not require, display of information representing a first bill and information representing a second bill on a single screen.

Each of claims 1-19 of the '322 patent requires a plurality of payor requests for billing information. Claims 34-63 of the present application lack any recitation of, and hence do not require, a plurality of payor requests for billing information.

Each of claims 1, 3-6, 8, 34, 36, and 40-57 of the '314 application requires at least one notice of availability of billing information, and each of claims 38 and 39 of the '314 application requires a notice of payment of less than a plurality of bills. Claims 34-63 of the present application lack any recitation of, and hence do not require, either at least one notice of availability of billing information, or a notice of payment of less than a plurality of bills.

Claims 34-63 of present application require a single screen having a first portion and a second portion. Displayed in the first portion is a bill of a biller that includes at least one of a total amount due and a minimum amount due, as well as a payment due date. Displayed in the second portion is bill payment information that includes a payment date area and a payment amount area. Claims 34-52 of the co-pending '629 application, claims 1-19 of the '322 patent, and claims 1, 3-6, 8, and 34-57 of the '314 application lack any recitation of, and hence do not require, such a single screen as recited in the claims of the instant application. Accordingly, the present application and claims 34-52 of the co-pending '629 application, claims 1-19 of the '322 patent, and claims 1, 3-6, 8, and 34-57 of the co-pending '314 application are directed to different inventions.

As the basis for the obviousness-type double patenting rejection has not been argued on a claim-by-claim basis, other features which distinguish claims 34-63 are

not individually discussed herein.

Accordingly, it is respectfully requested that the Examiner reconsider and withdraw the non-statutory obviousness-type double patenting rejection of claims 34-63.

Claims 34-45 and 56-63 stand rejected under 35 USC §101, as directed to non-statutory subject matter. The rejection is respectfully traversed.

Each of the rejected claims is directed to electronically presenting bills. As discussed in AT&T Corp. v. Excel Communications Inc., 510 USPQ 2nd 1447 (Fed. Cir. 1999) [quoted in Ex Parte Bowman], processes which are “electronic, chemical, or mechanical” are within the technological art or environment (See Ex Parte Bowman, 61 USPW 2nd at 1671).

Accordingly, to the extent that the two-prong test is still valid, it is respectfully submitted that the present claims meet both prongs of the test. That is, the claims recite a disclosed invention which is well grounded in an area of the technological arts (i.e., the electrical arts) [see Ex Parte Bowman, 61 USPQ 2nd at 1674] and, as acknowledged by the Examiner, clearly recite useful, concrete and tangible results. Therefore, it is respectfully requested that the rejection be reconsidered and withdrawn.

Claims 34, 38, 41-43, 46, 50-51, 53, and 54 stand rejected under 35 USC §102(b) as anticipated by Hogan (U.S. Patent No. 5,699,528). Claims 35-37, 39, 40, 44, 45, 47-49, 52, and 55-63 stand rejected under 35 USC §103(a) as obvious over Hogan. The rejections are respectfully traversed.

Hogan discloses two embodiments of an electronic bill presentation service. In both embodiments, a bill image is received from a biller and formatted for presentation (see, for example, column 4, lines 53-67, column 5, lines 53-57, and

column 9, lines 50-53). In the first embodiment, a subscriber retrieves the stored billing information from the bill service via the World Wide Web (see, for example, column 2, lines 32-35, and Figure 4), and in the second embodiment, the stored billing information is transmitted to the subscriber as an e-mail message by the bill service (see, for example, column 2, line 48-50, and Figure 11).

Independent claims 34, 46, and 56 each require, *inter alia*, displaying, in a first portion of a single screen, a bill of a biller including a payment due date and at least one of a total amount due and a minimum amount due, and displaying, in a second portion of the single screen, bill payment information including a payment date area for displaying a payment date, and a payment amount area for displaying a payment amount. The Examiner looks to Figure 4 for such a presentation.

Introduced above, Figure 4 is associated with the World Wide Web embodiment of Hogan. That is, the display of Figure 4 is presented to a user via the Web. While it is acknowledged that Figure 4 shows a bill of a biller, including a total amount due and information associated with a payment, Figure 4 in no way shows, and the associated text at column 6, lines 25-64, in no way discloses, a payment due date as required by the independent claims of the present application.

Furthermore, Figure 4 does not show a payment date. Rather, Figure 4, in detail 407, shows a user input area for either directing a payment on whatever date the user happens to be viewing the presentation of Figure 4 (shown as 'today'), or accessing a second presentation, different than that of Figure 4, to enter a specific payment date other than the instant date of viewing. The accessing of the second presentation to enter a specific payment date is described at column 6, lines 41-45. Thus, while a payment date might be displayed via a second presentation, a payment date is not displayed in the presentation of Figure 4.

Also, Figure 4 does not show a payment amount. Rather, Figure 4, in detail 411, shows a user input area for either directing a payment in the full bill amount, or directing a payment in an amount less than the full bill amount. Thus, the only displayed amount in Figure 4 is a billed amount, not a payment amount. Further, if a user wishes to enter a particular payment amount other than a full bill amount, the user must select either the 'allowed partial' detail or other 'grievance' detail. After doing so, as described in column 6, line 59, through column 7, line 5, a second presentation is displayed to the user so that the user can enter the particular payment amount. Thus, while a payment amount might be displayed via a second presentation, a payment amount is not displayed in the presentation of Figure 4.

As should be understood from the above, Hogan does not disclose a single screen for display of a payment due date, display of a payment date, and display of a payment amount, among other information.

Accordingly, it is respectfully requested that the Examiner reconsider and withdraw the rejection of independent claims 34, 46, and 56.

The dependencies of the present application recite further features that are both novel and unobvious. For example, claims 38, 50, and 57 each require, inter alia, the bill payment information to include a periodic payment area for directing future payments. The Examiner looks to detail 411 of Figure 4 for such. The Examiner's reliance upon detail 411 is simply not understood, as detail 411 is a payment amount entry area. In fact, Hogan lacks any disclosure whatsoever of a periodic, i.e., recurring, payment.

Claim 43, 54, and 61 each require, inter alia, that the single screen display a plurality of biller identifiers or a selectable biller list. The Examiner looks to Figures 10 and 11 for such. Figures 10 and 11 are associated with the e-mail embodiment

of Hogan. With reference to column 10, line 52, through column 11, line 37, Hogan discloses that a list of unpaid and/or unviewed e-mail billing items is presented to a user via a first display screen, shown in Figure 10. Each billing item of Figure 10 includes a biller's name, bill amount, and due date. In response to a user selection of one of the billing items of Figure 10, a second, different, display screen is then presented to the user, shown in Figure 11. Thus, Hogan does not teach or suggest a first portion of a single screen including a payment due date and at least one of a total amount due and a minimum amount due, a second portion of the single screen having bill payment information including a payment date area for displaying a payment date, a payment amount area for displaying a payment amount, and a plurality of biller identifiers or a selectable biller list, as required by claims 43, 54, and 61. In other words, Hogan discloses two screens (Figures 10 and 11) for displaying the same information required to be displayed in the single screen of claims 43, 54, and 61.

Claims 41 and 53 require, inter alia, changing a displayed payment date to a modified payment date and displaying the modified payment date in the bill payment information portion of the single display. The Examiner looks to detail 407 of Figure 4 for such. As should be understood from the above, Hogan does not disclose the requirements of claims 41 and 53, as Hogan does not display a payment date. Rather, as discussed above, Hogan merely displays an indication to direct a payment on the date the bill is being viewed. Also as discussed above, Hogan discloses a different screen for entering a particular payment date other than the instant date that a bill is being viewed.

The Examiner acknowledges that Hogan fails to teach a payment date which pre-dates the displayed payment due date by an amount of time corresponding to a

time period for making payment in a particular manner being automatically displayed initially in the payment date area as the payment date, as required by claims 35-37 and 47-49. However, the Examiner takes Official Notice that "it is old and well known in bill paying for biller to specify a time period where they no longer will receive checks but where the only payments accepted will be money orders or cash in order to avoid prolonging the time period of payment. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the payment period to corresponds [sic] to a time period for making a payment in a particular manner in order to obtain the above mentioned advantage."

Beyond Hogan not displaying a payment date, as discussed above, It is respectfully submitted that it was not 'old and well known' to include a displayed payment date that predates a due date based upon a period to make a payment in a particular manner. Thus, it is respectfully requested that the Examiner cite and properly apply prior art that teaches such in support of the Official Notice.

The Examiner acknowledges that the requirement of claim 39 that the displayed bill payment information include a payment status indicator indicating a status of payment of the displayed payment amount is not taught or suggested by Hogan. However, the Examiner again takes Official Notice, arguing that this feature is old and well known. The Examiner is respectfully requested to cite and properly apply prior art that teaches the requirements of claim 39 in support of this Official Notice.

Claims 40, 45, 52, 55, 59, and 63 require, inter alia, display of payment information in the form of a check. As best understood, the Examiner argues that while Hogan does not disclose display in the form of a check (see, for example,

page 14, first full paragraph of rejection), it would have been obvious to modify Hogan thusly. The Examiner cites no art in support of her conclusion. It is respectfully submitted that not only would it not have been obvious to so modify Hogan, but that the Examiner's position is purely speculative. As such, to the extent that the Examiner maintains the rejection of these claims, it is respectfully requested that the Examiner cite and properly apply prior art that discloses display of payment information in the form of a check, as required by claims 40, 45, 52, 55, 59, and 63.

Claims 44 and 62 require at least one of a first indicator corresponding to terms and conditions associated with the displayed bill, a second indicator corresponding to advertisements, and a third indicator corresponding to customer care. The Examiner, as best understood, acknowledges that Hogan does not teach or suggest an indicator associated with terms and conditions, or an indicator associated with advertisements. However, the Examiner takes Official Notice that it is old and well known "in bill payments to send advertisements with bills to induce the customers to make purchases" and that it would have been obvious to include such. It is respectfully respected that to the extent the Examiner maintains the rejections of claims 44 and 62 that the Examiner provide proper support for the Official Notice.

Further, the Examiner argues that the 'grievance' detail of Figure 4 corresponds to the recited customer care indicator. It is respectfully submitted that the Examiner is mistaken. Introduced above, the 'grievance' detail is for a user to enter in a payment amount less than a full payment amount in those instances in which the user disputes a payment amount. Thus, 'grievance' does not correspond to the recited customer care indicator.

The Examiner acknowledges that Hogan does not teach or suggest that the

bill payment information includes a payment made indicator for indicating that the displayed payment amount has been paid, as recited in claim 58. However, the Examiner again takes Official Notice that such is old and well known. To the extent the Examiner maintains the rejection, it is respectfully requested that the Examiner cite and properly apply prior art that teaches such in support of this Official Notice.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

The Official Action to which this Request for Reconsideration is responsive was returned to the United States Patent and Trademark Office as undeliverable to Applicants' representative, as evidenced by the attached photocopy of the original USPTO envelope stamped January 9, 2004 by Group 3600. Thereafter, the USPTO remailed the Official Action to Applicants' representative on March 15, 2004, after the expiration of the three month period for reply without Extension of Time. A photocopy of the March 15, 2004 post-marked envelope is also attached.

According to MPEP 707.13, which incorporates Ex Parte Gourtoff, 1924 C.D. 453, 629 O.G. 536 (Comm'r Pat. 1924), whenever an Official Action is returned to the USPTO because the U.S. Postal Service has not been able to complete delivery, "the Examiner should use every reasonable means to ascertain the correct address and forward the action again, after stamping it 'remailed' with the date thereof". Thereafter, the period running against the application for reply begins with the date of the remailing.

While the USPTO did remail the Official Action, the USPTO failed to stamp the action "remailed," and failed to restart the period for reply, as dictated by the MPEP and case law. The period for reply should have been restarted at the time of remailing (on or about March 15, 2004). Accordingly, in view of MPEP 707.13 and Ex Parte Gourtoff, an Extension of Time is not necessary in association with the instant Request for Reconsideration, as the same is being submitted within one month of the post-marked date of the remailed Official Action. However, should the USPTO determine that an Extension of Time is necessary, a one (1) month petition for an Extension of Time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including any necessary extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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